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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,095	05/24/2001	Douglas Madenberg	14403	2897
7590	08/23/2004		EXAMINER COFFY, EMMANUEL	
Steven Fischman SCULLY, SCOTT, MURPHY & PRESSER 400 Garden City Plaza Garden City, NY 11530			ART UNIT 2157	PAPER NUMBER

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/865,095	Applicant(s) MADENBERG ET AL.	
	Examiner Emmanuel Coffy	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed on 24 May, 2001. Claims 1-24 are pending. Claims 1-24 are directed to a "Method and System for Providing On-line Extensions of Off-line Places and Experiences."

Specification

2. The abstract in an application filed under 35 USC §111 may not exceed 150 words in length. See MPEP § 608.01(b). Appropriate correction is required.

Claim Objections

3. Each claim must be the object of a sentence starting with "I claim" or "We claim". See MPEP § 608.01(m). In this case the language: "Having thus described our invention, what we claim as new, and desire to secure by Letters Patent is:" is objected to. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 9, 12, 17, 19, and 24 are rejected for being indefinite. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render

a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 3, 9, 12, 17, 19, 24 recite the broad recitation "venue", and the claim also recite "location" which is the narrower statement of the range/limitation.

However, in order to expedite a more complete examination the Examiner asserts that this invention is understood as: "said venue includes a particular location."

5. Claim 4 is rejected under 35 U.S.C. §112 ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention due to ambiguous language from direct translation. A reasonable artisan skilled in the art could not comprehend the claims as written. The claim recites: "... wherein said location includes a particular event." It is not clear what the boundary of the claim is. Hence, the scope of the claim is unascertainable.

However, in order to expedite a more complete examination the Examiner asserts that this invention is understood as: "a specific upcoming event occurs in said location."

6. Claims 20 and 21 are rejected for their dependency on claim 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dong et al. (US 6,757,706) in view of Collins (US 5,963,951.)

Dong substantially teaches the invention as claimed including an apparatus for providing responses to requests of an off-line client comprising: a local request-response storage that stores a plurality of requests and a plurality of responses. (See abstract).

Claim 1:

Referring to claim1, Dong substantially teaches a method for extending off-line experiences between parties in an on-line context over a public communications network, said method including the steps of: (See Fig 7 – Fig. 11).

a) accessing a list of folder structures for on-line viewing via a web-browser device, each said folder structure associated with a particular location where a prior off-line experience had taken place and including one or more messages submitted by persons that relate to continuing a specific prior interaction involving said person and another at said location; (See col. 13, lines 41-51).

b) enabling said another person to select a folder and initiating display via said web-browser device of all messages submitted by users regarding their prior interactions at a selected location; (See col. 14, lines 21-50).

c) enabling said another person to select a message recognized as being submitted by said person and relating to a specific prior off-line experience with said person; and (See col. 14, lines 21-50).

d) in response to said selection, providing a link enabling user generation of a confidential reply message for continuing said prior off-line experience between said person and said another in an on-line context via said public communication network. (See col. 14, lines 1-20).

Dong teaches an insurance clerk wanting to visit customers in order to sell insurance and process a claim. The visit by the clerk while surfing the company's intranet constitutes an off-line experience between parties in an on-line experience context over a public communication network since applicant did not limit the claimed invention to any specific field of endeavor. The claim constitutes a message submitted by a person that relates to a specific prior interaction involving said person and another.

Dong does not explicitly suggest a location associated with an experience. However, Collins specifically discloses a geographic location associated with an off-line experience. (See col. 4, line 50 – col. 5, line 23).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Dong with the geographic location as disclosed by Collins. This system would make good use of the power of the web rather

than just using for advertising and directing users to a telephone system. Therefore, claim 1 is rejected.

Claim 2:

Referring to claim 2, Dong substantially teaches the method for extending off-line experiences between parties as claimed in claim 1, wherein prior to said step a), the step of:

enabling a first person to generate a message by specifying information including: a time and location where said prior off-line experience with a second person had taken place; and,

communicating said message over a public network for storage in said public accessible folder associated with the specified location.

Dong teaches an insurance clerk wanting to visit customers in order to process a claim. It is implicit that an insurance claim includes time and location where an off-line experience has taken place. (See col. 14, lines 9-18). Furthermore, Dong teaches storing the request-response storage at the company's server. (See col. 14, lines 46-50).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the teachings of Dong. Therefore, claim 2 is rejected.

Claim 4:

Referring to claim 4, Dong substantially teaches the method for extending off-line experiences between parties as claimed in claim 1, wherein a specific upcoming event occurs in said location.

Dong teaches an insurance clerk wanting to visit customers in order to process a claim. A meeting is an event, which occurs in a specific location in this case the client's home.

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the teachings of Dong. Therefore, claim 3 is rejected.

Claim 5:

Referring to claim 5, Dong substantially teaches the method for extending off-line experiences between parties as claimed in claim 2, wherein each person submitting a message has an associated inbox for receiving and storing e-mail messages, said step d) of providing a link enabling generation of said reply message includes:

displaying entry window enabling a second person to enter a reply message via said web-browser device;

formulating an e-mail including said reply message; and, transmitting said e-mail over said public communications network for automatic input to an inbox of said person for subsequent retrieval, wherein said inbox is not publicly accessible. (See col. 14, lines 51-54).

Dong teaches that computer professionals (a second person) of the insurance can edit the response-request storage. Dong does not explicitly suggest formulating an e-mail although Dong extensively discloses a system where e-mail capability is implicit. However, Collins discloses a personal mailbox at Fig. 7.

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the editing capability by a second person disclosed

by Dong with the personal mailbox of Collins. This system would make good use of the full potential and power of the web rather than just using it for advertising and directing users to a telephone system. Therefore, claim 5 is rejected.

Claim 6

Referring to claim 6, it recites the method for extending off-line experiences between parties as claimed in claim 2, wherein prior to said accessing step a), the step of organizing said list of public folders for display as a hierarchy of zones and locations within each zone, said accessing including the step of navigating to a particular location via said hierarchy.

Dong teaches a system for displaying and storing request-response but fails to explicitly suggest displaying folders as a hierarchy of zones and locations within each zone. However, Collins explicitly discloses a folder organized by zipcode (Fig. 6) and displaying a location as a hierarchy of zone (See Fig. 7 and col. 4, lines 50-65).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine displaying request-response capability as disclosed by Dong with the zip code and location disclosure of Collins. This system would make good use of the full potential and power of the web rather than just using it for advertising and directing users to a telephone system. Therefore, claim 6 is rejected.

Claim 8:

Referring to claim 8, it recites the method for extending off-line experiences between parties as claimed in claim 3, further including the step of initiating the display

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of advertisements associated with products and services of third party entities via said web-browser device.

Claim 8 is rejected as being unpatentable over admitted prior art (Admission) in view of Dong. Admission discloses using the web for advertising (See Collins col. 2, line 8).

Admission does not disclose expressly third parties' advertisements. However, Dong discloses third parties' services (See Fig. 6).

It would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine Admission with Dong to obtain initiating the display of advertisements associated with products and services of third party entities via said web-browser device. Therefore, claim 8 is rejected.

Claim 9:

Referring to claim 9, it recites the method for extending off-line experiences between parties as claimed in claim 8, further including the steps of selecting and displaying advertisements targeted for users having a presumed set of characteristics associated with a current selected venue location.

Claim 9 is rejected as being unpatentable over admitted prior art (Admission) in view of Collins. Admission discloses using the web for advertising (See Collins col. 2, line 8).

Admission does not disclose expressly users having a presumed set of characteristics. However, Collins discloses users having a presumed set of

characteristics associated with a current selected venue location. (See col. 4, lines 50-65).

It would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine Admission with Collins to obtain displaying advertisements targeted for users having a presumed set of characteristics associated with a current selected venue location. Using a presumed set of characteristics associated with a current selected venue location as a restrictive search criterion would yield at least one positive result. As such the targeted user's need would seem to be satisfied. Therefore, claim 9 is rejected.

Claim 17:

Referring to claim 17, it recites the system as claimed in claim 12, further including an ad rotator mechanism for displaying advertisements associated with products and services of third party entities for viewing by a user via said web-browser, said ad rotator mechanism selecting and displaying advertisements targeted for users having a presumed set of characteristics associated wherein said venue includes a particular location.

Claim 17 is rejected as being unpatentable over admitted prior art (Admission) in view of Collins. Admission discloses using the web for advertising (See Collins col. 2, line 8). Admission does not disclose expressly an ad rotator mechanism. However, Collins discloses a banner displaying users having a presumed set of characteristics associated with a current selected venue location. (See Fig. 5 and col. 4, lines 50-65).

It would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine Admission with Collins to obtain and ad rotator mechanism displaying advertisements targeted for users having a presumed set of characteristics associated with a current selected venue location. Such marketing technique has a probability of success. Therefore, claim 17 is rejected.

Claims 3, 7, 10-16, 18-24

These claims do not teach or define any significantly new limitations above and beyond claims 1-2, 4-9 to warrant particular treatment, and therefore, are rejected for similar reasons.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Jacobi et al. (U.S. 6, 317,722) teaches "Use of Electronic Shopping Carts To Generate Personal Recommendations."
- Mahiddini et al. (U.S. 6,751,649) teaches "Server for Searching For Information in a Network of Databases."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (703) 305-0325. The examiner can normally be reached on 8:30 - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

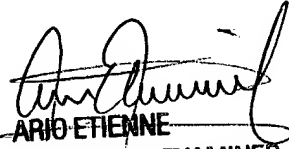
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Emmanuel Coffy
Patent Examiner
Art Unit 2157

EC
Aug 17, 2004


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